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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 08/567,564      | 12/05/95    | KOLLAR               | J 1469-1-001        |

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12M2/0422

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|---------------------|
| EXAMINER            |
| NAZARIO GONZALEZ, P |

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
| 1204     |              |

DATE MAILED: 04/22/97

**Please find below and/or attached an Office communication concerning this application or proceeding.**

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**08/567,564**

Applicant(s)  
**John Kollar**

Examiner  
**Porfirio Nazario-Gonzalez**

Group Art Unit  
**1204**



☒ Responsive to communication(s) filed on Apr 24, 1996

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-17 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-17 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Response to Letter***

1. Applicant's letter of April 24, 1996 requesting interference proceedings with U.S. Pat. No. 5,371,298 under 35 C.F.R. § 1.607(a)-(d) have been fully considered but moot in view of the following grounds of rejection.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-17 are rejected under 35 U.S.C. § 102(b) based upon a public use or sale of the invention. Redox Technologies Inc., in Exhibit 6 filed by Applicant on April 24, 1996, agreed to disclose the "Technology" which included the instant process to ARCO Chemical Company, a division of Atlantic Richfield Company ("ACC"), "for the purpose to evaluate the Technology to determine whether ACC desires to make an offer to Redox to acquire the Technology". This clearly constitutes an offer to sell the "Technology" to ARCO Chemical Company. Further, from the documents filed by Applicant the instant process was reduced to practice on July 27, 1979 and the experimental reproduction and/or evaluation of the "Technology" by ARCO alleged in page 2,

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item 3, was with the intent of buying the "Technology" and not refining it. It is clear that such experimentation was not experimental use within the meaning of the statute. See *TP*

*Laboratories v. Professional Positioners, Inc. et al.*, 724 F.2d at 971, 220 USPQ 577.

Therefore, Applicant commercially exploited the instant process, even though the process was kept secret. See *Mathis v. Hydro Air Industries, Inc.*, 1 USPQ2d, 1513, 1525. Thus, this constitutes a *prima facie* case of public use or sale under 35 U.S.C. § 102(b).

#### *Conclusion*

4. Applicant is requested to provide within the period for response of this Office action the remaining pages (pages 2-22) of Exhibit 3. Such material is required to make a determination of whether such document constitutes public use or sale under 35 U.S.C. § 102(b).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Nazario-Gonzalez whose telephone number is (703) 308-4632. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Geist, can be reached on (703) 308-1701. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

PNG  
April 18, 1997

  
PORFIRIO NAZARIO-GONZALEZ  
PRIMARY EXAMINER  
GROUP 1200